

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBORU KOBAYASHI and TOSHIYUKI HATTORI

Appeal No. 96-0005
Application 07/722,599¹

HEARD: July 15, 1997

Before McCANDLISH, **Senior Administrative Patent Judge**, and
MEISTER AND McQUADE, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

The prior decision on appeal mailed September 18, 1996 (Paper No. 35) is vacated in view of the oral hearing held on July 15, 1997.

¹ Application for patent filed June 27, 1991.

This is an appeal from the final rejection of claims 1, 3, 15, 16, 19, 20, 36, 37, 62 and 63.² Claims 4-14, 17, 18, 21-29, 32, 35 and 38-40 stand allowed. Claims 41-51, 64 and 65 have been indicated by the examiner to be allowable subject to the requirement that they be rewritten to include all the subject matter of the claims from which they depend.

As summarized on page 2 of the brief, the appellants' invention

is directed toward a type of watercraft which may be used in conjunction with a small conventional jet propelled type of watercraft so as to accommodate a larger number of passengers than that afforded by the smaller watercraft. However, the larger watercraft, sometimes referred to as the mother ship, has no propulsion unit of its own. In accordance with an important feature of the invention, the passenger compartment of the mother ship is laid out so that the controls of the smaller watercraft, when contained in a berthing area of the mother ship, can be reached by a seated passenger so that the combined watercraft may be propelled by the propulsion device of the smaller watercraft while being controlled from the larger watercraft.

Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

1. A watercraft comprised of a main hull devoid of any propulsion device or control therefor and defining a berthing area opening through a part of said main hull for receiving a smaller watercraft having a propulsion device and controls therefore, a passenger compartment defined by said main hull and

² Claim 62 has been amended by an amendment filed subsequent to final rejection on December 12, 1994 (Paper No. 29).

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having a portion at least partially juxtaposed to said berthing area on one side thereof, and an operator station positioned in said portion of said passenger compartment and containing means for accommodating an operator seated in a forwardly facing condition, said operator station, said berthing area and the controls of said smaller watercraft when positioned in said berthing area being arranged for direct operation of said controls by an operator seated within said operator station of said main hull passenger compartment while in a forwardly facing condition.

The references of record relied on by the examiner are:

Metcalf, Jr. et al. (Metcalf)	3,858,541	Jan. 7, 1975
Babb	3,865,062	Feb. 11, 1975
Yamaoka et al. (Yamaoka) (United Kingdom patent application)	2,046,689	Nov. 19, 1980
Yammer (Japanese patent publication)	2-28088	Jan. 30, 1990

Additional prior art relied on by this merits panel of the Board is:

The "popular type" of smaller watercraft of a "known form" that is powered by a jet propulsion unit and has a twist grip throttle control mounted on one of the pair of handle bars as disclosed in the appellants' specification on pages 1, 7 and 8 (the admitted prior art).

Claims 1, 15 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Metcalf.³

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Metcalf in view of Yamaoka. The examiner is of

³ The rejection of claim 16 on this ground was set forth as a new ground of rejection in the answer.

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the opinion that it would have been obvious to power the smaller watercraft of Metcalf by means of a jet propulsion unit in view of the teachings of Yamaoka.

Claims 19, 20, 36 and 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Metcalf in view of Babb and the Japanese publication. The examiner also believes that it would have been obvious to provide the watercraft of Metcalf with a winch in view of the teachings of Babb and a curved guiding area in view of the teachings of the Japanese publication.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the Japanese publication.⁴

Claims 62 and 63 stand rejected under 35 U.S.C. § 103 as being unpatentable over Metcalf.⁵

The examiner's rejections are explained on pages 4-8 of the answer. Rather than reiterate the arguments of the appellants and the examiner in support of their respective positions reference is made to the brief, reply brief, answer and supplemental answer for the full exposition thereof.

⁴ This rejection was set forth as a new ground of rejection in the answer.

⁵ This rejection was set forth as a new ground of rejection in the answer.

OPINION

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and reply brief and by the examiner in the answer and supplemental answer. As a consequence of this review, we will sustain the examiner's rejections of (1) claims 1 and 15 under 35 U.S.C. § 102(b) as being anticipated by Metcalf, (2) claim 1 under 35 U.S.C. § 102(b) as being anticipated by the Japanese publication, (3) claim 3 under 35 U.S.C. § 103 based on the combined disclosures of Metcalf and Yamaoka and (4) claims 19, 20, 36 and 37 under 35 U.S.C. § 103 based on the combined disclosures of Metcalf, Babb and the Japanese publication. We will not, however, sustain the examiner's rejection of claim 16 under 35 U.S.C. § 102(b) as being anticipated by Metcalf or claims 62 and 63 under 35 U.S.C. § 103 as being unpatentable over Metcalf. Additionally, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter new rejections of claims 3, 15, 16, 19, 20, 36, 37, 62 and 63 under 35 U.S.C. § 103.

Considering first the rejections under 35 U.S.C. § 102(b) of claims 1 and 15 as being anticipated by Metcalf and claim 1 as

anticipated by the Japanese publication, the appellants argue that neither Metcalf nor the Japanese publication shows a station on their large unpowered watercraft where an operator may sit in a forwardly facing direction in such a manner so as to be able to operate the controls of the smaller watercraft.⁶ We must point out, however, that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. ***See Verdegaal Brothers Inc. v. Union Oil Co. of California***, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), ***cert. denied***, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when that reference discloses, either expressly or under the principles of inherency, each and every element set forth in the claim (***RCA Corp. v. Applied Digital Data Systems, Inc.***, 730 F.2d

⁶ At oral hearing the appellants' counsel noted that independent claim 1 requires an operator station containing "means for accommodating an operator seated in a forwardly facing condition" and attempted to assert that the structure of Metcalf is not the "equivalent" of the structure disclosed in the appellants' specification for accomplishing this function within the meaning of the sixth paragraph of § 112. We decline to consider such an argument since it has not heretofore been raised, particularly in view of the fact that we do not have the benefit of the examiner's finding regarding equivalents. In making this determination we note that 37 CFR § 1.192(a) expressly requires that the brief contain all arguments on which the appellants intend to rely.

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1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984)) and the discovery of a new property or use of a previously known article, even when that property and use are unobvious from the prior art, cannot impart patentability to claims to the known article (*see In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)).

As our reviewing court set forth in *LaBounty Mfg. Inc. v. United States Int'l Trade Comm'n* at 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992) (in quoting with approval from *Dwight & Lloyd Sintering Co. v. Greenawalt*, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation.

This principle applies here inasmuch as the smaller watercraft 102 of Metcalf clearly has the **capability** of being operated

(without any change in structure whatsoever) by an operator seated on the deck panels 66 in a forwardly facing position adjacent the smaller watercraft's steering wheel (see Figs. 11 and 12). Similarly, in the embodiment of Figs. 11-15 of the Japanese publication, an operator sitting in either of the seating compartments 7 on the larger unpowered watercraft 25 clearly has the **capability** of reaching and operating the controls 4 of the smaller powered watercraft 1.⁷ Stated differently, the watercrafts of Metcalf and the Japanese publication would not undergo a metamorphosis to new watercrafts simply because the smaller watercrafts were operated by a person seated on the larger unpowered watercrafts in a forwardly facing position adjacent the smaller water crafts' steering mechanism. **See In re Pearson**, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and **Ex parte Masham**, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

⁷ In making the determinations that Metcalf and the Japanese publication have such capability we note that, while patent drawings are not drawn to scale, they may nevertheless be used to establish relative sizes and relationships between the various components which are clearly depicted therein. **See, e.g., Vas-Cath Inc. v. Mahurkar**, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991), **In re Mraz**, 455 F.2d 1069, 1072, 173 USPQ 25, 27 (CCPA 1972), **In re Heinle**, 342 F.2d 1001, 1007, 145 USPQ 131, 136 (CCPA 1965) and **In re Wolfensperger**, 302 F.2d 950, 959, 133 USPQ 537, 544 (CCPA 1962).

With respect to claim 15 the appellants argue that the cover for the berthing area in Metcalf is really not "removable." We must point out, however, it is well settled that the claims in a patent application are to be given their broadest reasonable interpretation during prosecution of a patent application (**see In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (**see Sjolund v. Musland**, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). This being the case, we are of the opinion that the cover 66 of Metcalf which is mounted by hinges in such a manner that it can selectively be moved to cover or uncover the berthing area can be considered to be "removable" as broadly claimed.

In view of the foregoing, we will sustain the examiner's rejections under 35 U.S.C. § 102(b) of claims 1 and 15 as being anticipated by Metcalf and claim 1 as anticipated by the Japanese publication.

Turning to the rejection of claim 16 under 35 U.S.C. § 102(b) as being anticipated by Metcalf, the examiner has taken the position that the top of the cover 66 would form a plurality of seats when folded to the position illustrated in Fig. 12. In our view, the examiner is attempting to expand the meaning of "a

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plurality of seats" beyond all reason. Terms in a claim should be interpreted in a manner consistent with the specification and construed as those skilled in the art would construe them (***see In re Bond***, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), ***Specialty Composites v. Cabot Corp.***, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and ***In re Sneed***, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, we can think of no circumstances where the artisan, consistent with the appellants' specification, would construe the folded over cover 66 of Metcalf to form a plurality of seats. This being the case, we will not sustain the examiner's rejection of claim 16 under 35 U.S.C. § 102(b) as being anticipated by Metcalf.

Considering next the rejection of claim 3 under 35 U.S.C. § 103 as being unpatentable over Metcalf in view of Yamaoka, the appellants argue that the jet propulsion unit of Yamaoka is in a "conventional" boat and not in the combination of a powered and unpowered hull as claimed. Such a contention is not persuasive inasmuch as nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. ***See In re Merck & Co.***, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Here, the examiner has relied upon the primary reference to Metcalf for

a teaching of the combination of a powered and unpowered hull and upon Yamaoka for a teaching that propellers (see, e.g., the embodiment of Fig. 12) and jet propulsion units (see the embodiments of Figs. 18 and 20) are art recognized alternatives to propel watercraft. From our perspective, a combined consideration of Metcalf and Yamaoka would have fairly suggested to the artisan to provide the small powered watercraft of Metcalf with a jet propulsion unit as a motive means in view of Yamaoka's teaching of such an arrangement in Figs. 18 and 20. Accordingly, we will sustain the examiner's rejection of claim 3 under 35 U.S.C. § 103 based on the combined disclosures of Metcalf and Yamaoka.

Treating now the rejection of claims 19, 20, 36 and 37 under 35 U.S.C. § 103 as being unpatentable over Metcalf in view of Babb and the Japanese publication, the appellants concede that Babb teaches a winch but nevertheless question why someone skilled in the art would want to "winch" the smaller watercraft 102 of Metcalf into its berthing area in the larger watercraft. Noting that the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (***see In re Bozek***, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), we are of the opinion that it would have been self-evident to the artisan as a matter of common sense that

the provision of a winch as taught by Babb on the larger unpowered watercraft of Metcalf would allow the berthing of smaller powered watercraft 102 in a more controlled and slow manner than would be possible utilizing the propulsion unit of the smaller watercraft, thus minimizing the risk of damage to either the smaller or larger watercraft of Metcalf. Therefore, we are of the opinion that one of ordinary skill in this art would have found it obvious to provide the larger watercraft of Metcalf with a winch such as that disclosed by Babb at 22 in order to achieve this self-evident advantage.

With respect to claim 20 the appellant argues that:

[t]he Examiner contends that Yammer [sic, Yanmar], the Japanese publication, shows curved sides. This is true, but in Yammer [sic, Yanmar] the sides are flexible and the small hull is paced the larger hull by deforming the floating hull rather than by merely guiding the boat into it. [Brief, page 9.]

We find nothing in the Japanese publication which states that the larger hull is deformed as the appellants contend. In any event, even if this is the case, it takes nothing away from the fact that the Japanese publication teaches the provision of curved sides and we share the examiner's view that it would have been obvious to make the wall of the berthing area of Metcalf curved in view of this teaching by the Japanese publication.

With respect to claim 36 the appellants contend that there is no teaching of a "recess" as they have illustrated in Figs. 5 and 6. We must point out, however, that it is well settled that the claims in a patent application are to be given their broadest reasonable interpretation during prosecution of a patent application (*see In re Zletz*, 893 F.2d at 321, 13 USPQ2d at 1322) and limitations from a pending application's specification will not be read into the claims (*see Sjolund v. Musland*, 847 F.2d at 1581-82, 6 USPQ2d 2027). Here, the appellants have only broadly set forth in claim 36 the provision of a "recess to receive the bow of the smaller watercraft when received in the berthing area" This being the case, we share the examiner's view that the Japanese publication teaches a recess as broadly claimed at 27 in Fig. 13 and it would have been obvious to provide the watercraft of Metcalf with such a recess in view of this teaching.

In view of the above, we will sustain the examiner's rejection of claims 19, 20, 36 and 37 under 35 U.S.C. § 103 based on the combined disclosures of Metcalf, Babb and the Japanese publication.

Considering now the rejection of claims 62 and 63 under 35 U.S.C. § 103 as being unpatentable over Metcalf, the examiner has stated that:

[i]t would have been an obvious expedient to one having ordinary skill in the art at the time the invention was made to provide floor 66 (see Fig. 12) of Metcalf with a cushion, in order to permit the flaps 66 to close but still protect the top of the craft 102 from damage when 66 is folded over the top of 102; or to provide a cushioned area to sit when 66 is folded out as shown in Fig. 12. [Answer, page 8.]

We must point out, however, that obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)) and the examiner may not resort to speculation or unfounded assumptions to supply deficiencies in establishing a factual basis (*see In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967)), **cert. denied**, 389 U.S. 1057 (1968). Stated differently, the subjective opinion of the examiner as to what is or is not obvious, without evidence in support thereof, does not provide a factual basis upon which the legal conclusion of obviousness can be reached. Instead, it is well settled that in order to establish a **prima facie** case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the claimed invention. *See, e.g., In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). Here, the examiner has made the bald assertion that it would have been obvious to provide a cushion on the hinged cover of Metcalf in such a manner to permit

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the hinged cover to, on the one hand, close to prevent damage to the powered smaller watercraft and, on the other hand, serve as a seat in the open position without providing any evidence or factual basis whatsoever to support this assertion. It therefore follows we will not sustain the examiner's rejection of claims 62 and 63 under 35 U.S.C. § 103 as being unpatentable over Metcalf.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections.

Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over the Japanese publication in view of the admitted prior art. It would have been obvious to one of ordinary skill in this art to utilize the "conventional" jet propelled type of watercraft of the admitted prior art in the embodiment of Figs. 11-15 of the Japanese publication if, for no other reason, to achieve the advantage of ease of availability.

Claims 15 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over the embodiment of Figs. 11-15 of the Japanese publication in view of Metcalf. It would have been obvious to one of ordinary skill in this art to provide the larger watercraft 25 of the Japanese publication with a removable cover over the berthing area in order to achieve the advantage of providing "a smooth unbroken deck surface for use by passengers"

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as taught by Metcalf in column 4, lines 11-12. As to claim 16, the artisan would as a matter of common sense (**see *In re Bozek***, 416 F.2d at 1390, 163 USPQ at 549) found it obvious to provide the passenger compartment 7 of the admitted prior art with plural seats.

Claims 19, 20, 36 and 37 are rejected under 35 U.S.C. § 103 as being unpatentable over the Japanese publication in view of Babb. It would have been obvious to one of ordinary skill in this art to provide the larger watercraft 25 of the embodiment of Figs. 11-15 of the Japanese publication with a winch as taught by Babb at 22 in order to achieve the self-evident advantage of allowing the berthing of smaller powered watercraft 1 in a more controlled and slow manner than would be possible utilizing the propulsion unit of the smaller watercraft 1, thus minimizing the risk of damage to either the smaller or larger watercraft.

Claims 62 and 63 are rejected under 35 U.S.C. § 103 as being unpatentable over the Japanese publication. Noting that artisans must be presumed to know something about the art apart from what the references disclose (**see *In re Jacoby***, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (**see *In re Bozek***, 416 F.2d at 1390, 163

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USPQ at 549), we perceive the artisan would have been well aware of the customary practice of providing cushions for boat seats and would have found it obvious to utilize cushions on the seats in the passenger compartment 7 of the embodiment of Figs. 11-15 of the Japanese publication.

In summary:

The examiner's rejections under 35 U.S.C. § 102(b) of claims 1 and 15 as being anticipated by Metcalf and claim 1 as being anticipated by the Japanese publication are affirmed.

The examiner's rejection of claim 16 under 35 U.S.C. § 102(b) as being anticipated by Metcalf is reversed.

The examiner's rejections under 35 U.S.C. § 103 of claim 3 based on the combined disclosures of Metcalf and Yamaoka and claims 19, 20, 36 and 37 based on the combined disclosures of Metcalf, Babb and the Japanese publication are affirmed.

The examiner's rejection of claims 62 and 63 under 35 U.S.C. § 103 based on Metcalf is reversed.

New rejections of claims 3, 15, 16, 19, 20, 36, 37, 62 and 63 under 35 U.S.C. § 103 have been made.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based

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upon the same record must be filed within one month from the date hereof (37 CFR § 1.197).

With respect to the new rejections under 37 CFR § 1.196(b), should appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellants elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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AFFIRMED-IN-PART
37 CFR § 1.196(b)

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Senior Administrative Patent Judge)	
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JAMES M. MEISTER)	BOARD OF PATENT
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